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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,348	01/12/2001	Rolf Kaindl	2206.0019C	9312

7590 01/14/2004  
EPSTEIN, EDELL, SHAPIRO & FINNAN  
Suite 400  
1901 Research Boulevard  
Rockville, MD 20850-3164

EXAMINER

CRAVER, CHARLES R

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 01/14/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/758,348**

Applicant(s)  
**Kaindi**

Examiner  
**Charles Craver**

Art Unit  
**2682**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 10, 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-18 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 12, 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other:  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5, 6, 8-13 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Lemke et al.

**Claims 1, 2 and 11:** Lemke discloses a test equipment and method for calibrating said cellular test equipment (1, col 10 lines 4-48), comprising

sampling at least a portion of data between a base station and mobile stations (col 18 lines 3-44), and based on measured data, calibrating the device, including determining a reference frequency (col 18 line 45-col 19 line 3), wherein the test equipment passively listens to said base-mobile communications (col 10 lines 49-62).

**Claim 3:** the stream of information would inherently be periodical, since it flows according to a given frequency.

**Claim 5:** since Lemke discloses sampling any data, such would inherently include data establishing the connection. **Claim 6:** the reference is determined electrically (col 18 line 45-col 9 line 3). **Claim 8:** since the invention of Lemke may be used at any time, such a situation in

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which the measurements are taken after a particular mobile has established a synchronization with the base station, would be an inherent possible scenario in Lemke. **Claim 9:** a mobile station must inherently be registered (booked) to the network prior to establishing communications between it and the base station. **Claim 10:** Lemke discloses an antenna for said listening (20).

**Claims 12, 13 and 16:** Lemke discloses a test equipment and method for calibrating said cellular test equipment (1, col 10 lines 4-48), comprising

sampling at least a portion of data between a base station and mobile stations (col 18 lines 3-44), and based on measured data, calibrating the device, including determining a reference frequency (col 18 line 45-col 19 line 3), wherein the test equipment passively listens to said base-mobile communications (col 10 lines 49-62). **Claim 15:** Lemke discloses a real-time display (8, col 16 line 55-col 17 line 55). **Claim 18:** Lemke discloses an antenna for said listening (20).

**Claim 17:** Lemke discloses that the calibration may include physically disconnecting a cable, which reads mechanically.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lemke as applied to claim 1 above.

While disclosing applicant's invention of claim 1 above, Lemke fails to disclose an asynchronous mode. However, the use of either a synchronous or asynchronous mode in a radio communicator device was notoriously well-known in the art at the time of the invention, and as such the examiner takes Official Notice of such a feature, asserting that it would have been obvious to one of ordinary skill in the art at the time of the invention to use either a synchronous or asynchronous mode in order to match a synchronous or asynchronous network.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lemke as applied to claim 12 above.

While disclosing applicant's invention of claim 12 above, Lemke fails to disclose a quartz oscillator, however, given that the use of such was notoriously well known in the art at the time of the invention, the examiner takes Official Notice of such a feature, asserting that it would have been obvious to one of ordinary skill in the art at the time of the invention to use a quartz oscillator as they are accurate and plentiful.

*Allowable Subject Matter*

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6. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 4 teaches towards a method for passively listening to cellular communication bit streams between a mobile and a base station and sampling and compiling data for calibrating a reference frequency thereby, wherein the calibration includes a step of measuring the frequency errors of the bit streams and minimizing such in order to calibrate the aforementioned reference frequency.

*Response to Arguments*

7. Applicant's arguments filed 10-29-03 have been fully considered but they are not persuasive.

Regarding Lemke, the examiner supports the rejection noted above, noting that the claimed language is broadly written and thus Lemke is sufficient to anticipate the instant claims. Note claim 1, where it is stated that the measuring unit passively listens to an established communication, that such communication is not taught as being between the listening device and the communication net, only that it is a communication between an arbitrary mobile unit and the net. Lemke discloses passively measuring communication channels between mobile stations and base stations, which is read by the examiner as "listening" to the communication channels. Further, storing the measured data and translating such, as taught by Lemke, is further read by the

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examiner as sampling and evaluating the data. Lastly, regarding the calibrating of a reference frequency, such is taught by Lemke in col 18 line 45-col 19 line 3. Given that claim 1 only recites calibrating a frequency, such a recitation is sufficient to anticipate such a limitation.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., portions recited from the specification) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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**9. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

**Or:**

(703) 872-9314 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal  
Drive, Arlington VA, sixth floor (receptionist).

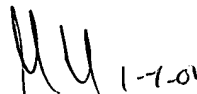
10. Any inquiry concerning this communication or earlier communications from the examiner  
should be directed to Charles Craver whose telephone number is (703) 305-3965.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Vivian Chin, can be reached on (703) 308-6739.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the Group receptionist whose telephone number is (703) 305-4700.

cc

C. Craver  
January 7, 2004

  
**CHARLES CRAVER**  
**PATENT EXAMINER**